INDEX

	Page
Opinions Below	1
Jurisdiction	1
Questions Presented	2
Introductory Statement	2
Constitutional Provisions and Statutes Involved	3
Statement of Facts	3
Reasons for Granting the Writ	9
I. As to the Certiorari Policy	9
II. As to the Substantive Issues	16
Conclusion	21

APPENDIX

A. Constitutional and Statutory Provisions	1a
B. Opinion of the Court of Appeals	3a
C. Judgment of the Court of Appeals	12a
D. Order Denying Petition for Rehearing En Banc	13a
E. Opinion of the District Court	14a

CITATIONS

CASES:

Amp Inc. v. Vaco Products Co., 280 F. 2d 518 (7th Cir. 1960), cert. denied, 364 U.S. 921 (1960) 12, 21

Beatty Safway Scaffold Co. v. Up-Right, Inc., 306 F. 2d 626 (9th Cir. 1962), cert. denied, 372 U.S. 934 (1963) 11

Brulotte v. Thys Co., U. S. Supreme Ct., No. 20, decided November 16, 1964 16

Castro Convertible Corp. v. Bebry Bedding Corp., 291 F. 2d 306 (2d Cir. 1961), cert. denied, 368 U.S. 925 (1962) 12, 21

Page

Cuno Engineering Corp. v. Automatic Devices Corp., 314 U.S. 84 (1941) 11, 16
Electric Cable Joint Co. v. Brooklyn Edison Co., 292 U.S. 69 (1934) 16
Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147 (1950) 10, 11, 13, 17, 19
Hartford-Empire Co. v. United States, 323 U.S. 386 (1945); 324 U.S. 570 (1945) 15
Helms Products, Inc. v. Lakeshore Manufacturing Co., 227 F. 2d 677 (7th Cir. 1955) 12
John Deere Co. v. Graham, 333 F. 2d 529 (8th Cir. 1964), cert. pending, No. 580 9
J. R. Clark Co. v. Geuder, Paeschke & Frey Co., 259 F. 2d 737 (7th Cir. 1958), cert. denied, 359 U.S. 914 (1959) 12, 21
Jungersen v. Ostby & Barton Co., 335 U.S. 560 (1949) 17, 19, 21
Lorenz v. F. W. Woolworth Co., 304 F. 2d 102 (1962) 15, 19, 21
Norman v. Lawrence, 285 F. 2d 505 (2d Cir. 1960) ... 12, 21
Radiator Specialty Co. v. Micek, 327 F. 2d 554 (9th Cir. 1964), cert. denied, No. 121, October 12, 1964 11
Reiner v. I. Leon Co., 285 F. 2d 501 (2d Cir. 1960), cert. denied, 366 U.S. 929 (1961) 12, 21
Rogers v. Missouri Pacific R. Co., 352 U.S. 500 (1957) 10, 12
Ry-Lock Co. v. Sears, Roebuck & Co., 227 F. 2d 615 (9th Cir. 1955), cert. denied, 350 U.S. 987 (1956) 12
Squeez-A-Purse Corp. v. Stiller, 280 F. 2d 424 (6th Cir. 1960), cert. denied, 364 U.S. 828 (1960) 12, 21
United States v. Besser Mfg. Co., 96 Supp. 304 (E. D. Mich. 1951), aff'd, 343 U.S. 444 (1952) 15
United States v. Masonite Corp., 316 U.S. 265 (1942) 15
United States v. National Lead Co., 332 U.S. 319 (1947) 15
United States v. New Wrinkle, Inc., 342 U.S. 371 (1952) 15
United States v. Singer Mfg. Co., 374 U.S. 174 (1963) .. 15
United States v. United Shoe Machinery Corp., 110 F. Supp. 295 (D. Mass. 1953), aff'd per curiam, 347 U.S. 521 (1954) 15

Page

United States v. United States Gypsum Co., 333 U.S. 364 (1948) 15
United States v. Univis Lens Co., 316 U.S. 241 (1942).. 15
Zysset v. Popeil Bros., Inc., 276 F. 2d 354 (7th Cir. 1960), cert. denied, 364 U.S. 827 (1960), 318 F. 2d 701 (7th Cir. 1963), cert. denied, 376 U.S. 913 (1964) 11

CONSTITUTIONAL PROVISIONS AND STATUTES:

28 U.S.C. § 1254(1) 2
28 U.S.C. §1338(a) 2
28 U.S.C. § 2201 2
Patent Code of 1952, 35 U.S.C. §§ 101-103 ..... 2, 3
U. S. Constitution, Article I, Section 8, Clause 8 3

MISCELLANEOUS:

"An Analysis of Patent Litigation Statistics," Staff Report, Subcommittee on Patents, Trademarks and Copyrights, Senate Judiciary Committee, 86th Cong., 2d Sess. (1961) 9, 11, 15
Chin, The Statutory Standard of Invention; Section 103 of the 1952 Patent Act, 3 Patent, Trademark & Copyright J. of Res. & Ed. 317 (1959) 9
Comment, 63 Colum. L. Rev. 306 (1963) 9
Frank, Marble Palace (1958) 13, 14
Stedman, The U. S. Patent System and Its Current Problems, 42 Texas L. Rev. 450 (1964) 15, 20
U. S. Patent Office, Index of Patents (1963) 14

IN THE

Supreme Court of the United States

OCTOBER TERM, 1964

No.

CALMAR, INC., *Petitioner,*

v.

COOK CHEMICAL COMPANY, *Respondent.*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT

Petitioner, Calmar, Inc., prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Eighth Circuit in the above-entitled case.

OPINIONS BELOW

The opinion of the Court of Appeals is reported at 336 F.2d 110, and is reprinted in the Appendix, p. 3a, *infra.* The opinion of the District Court for the Western District of Missouri is reported at 220 F. Supp. 414, and is reprinted in the Appendix, p. 14a, *infra.*

JURISDICTION

The judgment of the Court of Appeals was entered on August 21, 1964 (Appendix, p. 12a, *infra*). A timely Petition for Rehearing En Banc was denied on October 9, 1964 (Appendix, p. 13a, *infra*). The jurisdic-

tion of this Court is invoked pursuant to 28 U.S.C. § 1254(1). The basis of jurisdiction in the District Court was 28 U.S.C. §§ 1338(a) and 2201.

QUESTIONS PRESENTED

As to the Certiorari Policy: Should not this Court at this point end its practice of the past fourteen years of leaving final authority in patent cases to the Courts of Appeals—a practice which has caused a degradation of the standard of patentability, leading to unjustifiable monopolization of many segments of the economy—and participate once again in this field by granting certiorari in this extreme case which vividly illustrates the recurrent abuse and debasement of the constitutional standard of patentability?

On the Merits: Respondent's assignor obtained a patent (Scoggin, No. 2,870,943) purporting to cover the combination, with a finger-operated pump-type liquid sprayer, of a cap designed to hold the plunger of the pump down during shipment, and having various specified mechanical details. It is undisputed that the use of the pump-type sprayer, the use of the cap, and the use of the two together were old.

The question presented is: Whether, because of the addition to these old elements of a ring serving as a sort of washer between the cap and the plunger collar, an addition obvious and disclosed by the prior art, the patent in question embodies a patentable "invention" under the Constitution and §§ 101-103 of the Patent Code?

INTRODUCTORY STATEMENT

For fourteen years this Court has not considered, on the merits, a case concerning the issue of patent validity. During this time, many Petitions for

Certiorari raising this issue have been presented to it. Analysis indicates that an average of ten such petitions are presented each Term. At least fifty cases per year involving the issue of patent validity are decided by the Courts of Appeals. Considerable diversity of opinion has developed in the Courts of Appeals as to the standard of patentability during these fourteen years. There is a line of cases—of which we submit this case is the nadir—in which the patenting of trivial gadgets has been countenanced by the Courts of Appeals.

We shall show in this Petition that this case furnishes an ideal opportunity for this Court, by granting certiorari, to reassert its authority and participate once again in the current of adjudication in this area. By doing so, it would support the Constitutional standard of patentability established by an unbroken line of its earlier decisions.

CONSTITUTIONAL PROVISION AND STATUTES INVOLVED

This case involves Article I, Section 8, Clause 8, of the Constitution, and Sections 101, 102 and 103 of the Patent Code of 1952, 35 U.S.C. §§ 101, 102 and 103. These provisions are set forth in the Appendix, beginning at p. 1a, *infra.*

STATEMENT OF FACTS

Petitioner is a distributor of finger-operated plastic sprayers for dispensing liquids. (R. 72)[1] Respondent is an insecticide manufacturer which, since 1956, has

[1] The record references are to the two-volume printed record prepared for the Court of Appeals. Volume 1 (pp. 1-339) contains the pleadings and judgment, and the transcript of the testimony printed for the Court of Appeals; Volume 2 (pp. 341-553) contains the exhibits submitted to the Court of Appeals, including the various patents involved. We have filed nine copies of this record with this Petition.

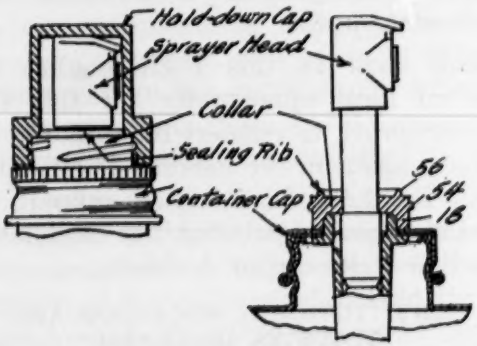
also been engaged in the manufacture of finger-operated plastic sprayers. (R. 50, 55)

In 1959, U. S. Patent No. 2,870,943 was issued to respondent as assignee of one Baxter I. Scoggin, Jr. (R. 510). The device involved in the patent is shown below:

Scoggin Pat. 2,870,943
Fig. 1

Scoggin Pat. 2,870,943
Fig. 2

(See Ex. 10, R. 510)



At this time, petitioner was selling its plastic sprayer with hold-down cap, which it had developed in 1958 (R. 75, 77), called the Calmar SS-40. This was sold to the trade, including insecticide manufacturers competing with respondent. (R. 74). Respondent charged that petitioner's SS-40 infringed the Scoggin patent. (R. 2, 3). Petitioner then sued respondent in the District Court for a declaratory judgment that the Scoggin patent was not valid, or was not infringed; respondent counterclaimed for infringement. (R. 1-4).

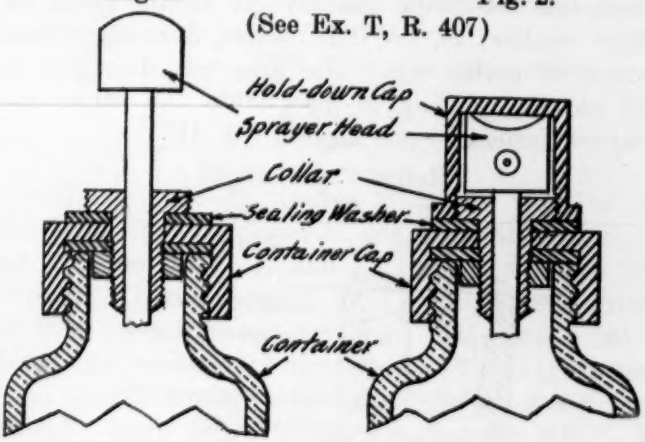
The Scoggin patent had nothing to do with the pump or plunger itself; it simply related to certain details of the cap to be used over the plunger. (R. 512).

Moreover, it was undisputed that there was nothing new in the idea of applying a screw-threaded cap over a liquid-dispenser plunger to hold it down and provide a seal over the dispenser during shipment. (R. 26). A striking example of this idea is found in Lohse Patent No. 2,119,884, issued in 1938, which had long since expired when the events in suit occurred (R. 407):

Lohse Pat. 2,119,884
Fig. 1.

Lohse Pat. 2,119,884
Fig. 2.

(See Ex. T, R. 407)



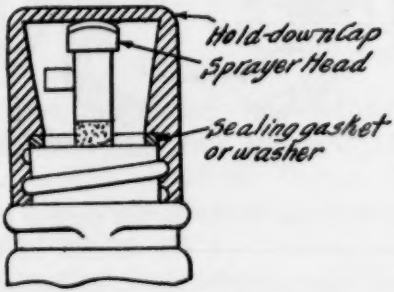
The only difference between the device illustrated in the old Lohse patent, and the device in the Scoggin patent—which was manufactured by respondent from August 1957 until November 1959 as the "Bakan 2" sprayer[2]—is that the Scoggin device effects a seal above the screw threads in the cap, while the Lohse device effects a seal below the screw threads.—The

[2] The Bakan 2 sprayer, like Petitioner's sprayer, is of the sort sold on liquid tire cleaners, spray starches, insecticides, and the like, in supermarkets and grocery stores.

idea of the cap, like most bottle caps, is to keep the contents in the bottle and not let them leak out. The reason for the seal is to prevent any liquid which might have flowed out of or around the plunger into the overcap, from further flowing out of the overcap. In the Scoggin device a rib in the underside of the overcap pressed against the top of the plunger collar.

The idea of effecting a seal for fluids above a thread[3] is, of course, old as well as obvious. The common garden-hose coupling employs it in the form of a rubber washer; as, for that matter, does the ordinary screw-type bottle cap. The idea was disclosed in a 1952 patent, relating to insecticide and other liquid sprayers, issued to one Mellon (R. 410):

Mellon Pat. 2,586,687
Fig. 3
(See Ex. U, R. 410)



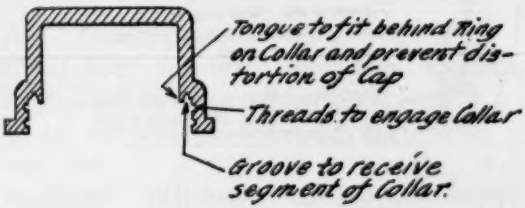
[3] It is said that the location of the seal was necessary to prevent the threads from "corroding." (Respondent's Ct. Apps. Br. 50). Why this would be necessary in a plastic device is mysterious. Scoggin testified that his experiments indicated that the top of the bottle cap, below the overcap threads, was an unsuitable place to put the seal. (R. 151). But the device produced commercially under the Lohse patent, which used a seal below the threads, produced a satisfactory, leak-proof assembly. (R. 286). In any event, the basic point is that relocating the seal is not "invention," either in itself or in light of the prior art.

Moreover, two patents issued for spout covers to one Livingstone in 1955 and 1956 disclosed this idea; in fact, in a form superior to that exemplified in the Scoggin patent. (R. 385, 390). We illustrate one:

Livingstone Pat. 2,715,480

Cap of Fig. 8

(See Ex. H, R. 385)

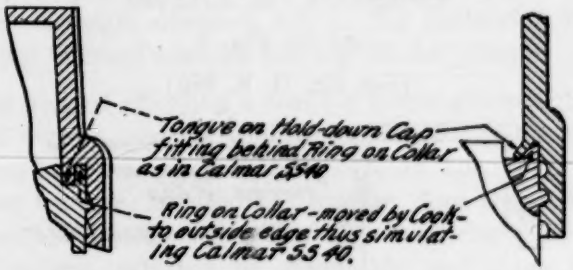

Tongue to fit behind ring on Collar and prevent distortion of Cap
Threads to engage Collar
Groove to receive segment of Collar

Petitioner's SS-40 used a different type of seal joint from that disclosed in the Scoggin patent and used in respondent's Bakan 2. Petitioner's seal joint (similar to Livingstone's) used a tongue and groove, like that used in wood flooring. This seal joint inhibited the tendency to distortion and leakage present in the simple contact seal illustrated in the Scoggin patent.[4] More importantly, Petitioner's SS-40 had internal pump seals which prevented the liquid from getting out of, or around, the plunger into the overcap. (R. 305-07). Less than a year after the introduction of petitioner's SS-40, respondent modified its

[4] In a later patent application, Scoggin admitted the distortion caused by the very seal which he had patented. (R. 507). Moreover, the respondent, in announcing the Bakan 2 Modified, an improved version of its overcap (adopting petitioner's seal), publicly admitted that the Scoggin seal was imperfect. (R. 341).

"Bakan 2" to make the overcap seal conform generally to the Calmar SS-40[5] (R. 341):

Calmar SS 40	Bakan 2—Modified
(See Ex. QQ, R. 475)	(See Ex. 90, R. 517)


Tongue on Hold-down Cap fitting behind Ring on Collar as in Calmar SS40
Ring on Collar - moved by Cook to outside edge thus simulating Calmar SS 40.

The District Court held that the "combination of the admittedly old and known elements employed by Scoggin" was a patentable invention; that Scoggin Patent No. 2,870,943 was valid; and that petitioner's SS-40 sprayer infringed it.[6]

The Court of Appeals affirmed.

---

[5] This modification (the "Bakan 2 Modified") was on the market in November 1959. (R. 341). By mid-1960, respondent had also introduced a new model, the Bakan 3, with internal pump seals which, like petitioner's SS-40 introduced over a year before, prevented the toxic contents of the bottle from flowing into the overcap. (R. 157).

[6] The District Court reserved jurisdiction with respect to the amount of damages to be awarded respondent for the infringement; and certified, under Fed. R. Civ. Proc. 54(b), that there was no reason for delay in entering judgment on the issues of validity and infringement, and directed entry of judgment thereon. (R. 37-38).

REASONS FOR GRANTING THE WRIT

I. AS TO THE CERTIORARI POLICY

This Court has not heard a patent case involving the issue of validity for fourteen years. An average of about fifty cases involving the issue of patentability are decided annually in the Courts of Appeals,[7] and numerous petitions for certiorari to review those decisions have been presented to this Court in this period.

It seems fair to say that this Court's long-continued failure to hear a case involving this issue is itself one of the most important factors in present-day patent law. It is difficult to imagine that many of the recent decisions[8] upholding patents on petty gadgets, including the decision below—which while paying lip service to this Court's prior holdings obviously applies a trivial standard of invention—could have been rendered had there been a tradition of active supervision by the Court in this area.

Congressional Committee studies and legal commentators[9] have dwelt on the doctrinal diversity

---

[7] See, in particular, the statistics for 1951-58 collected in "An Analysis of Patent Litigation Statistics," Staff Report, Subcommittee on Patents, Trademarks and Copyrights, Senate Judiciary Committee, 86th Cong., 2d Sess. 24-25 (1961).

[8] See the cases collected in note 13, *infra*.

[9] See "An Analysis of Patent Litigation Statistics," *supra* note 7, at 1; Comment, 63 Colum. L. Rev. 306, 324 (1963); Chin, The Statutory Standard of Invention; Section 103 of the 1952 Patent Act, 3 Patent, Trademark & Copyright J. of Res. & Ed. 317, 322 (1959). The forum shopping that the situation produces is commented on in the Congressional Committee study, "An Analysis of Patent Litigation Statistics," *supra*, at 30 n. 6. The differences in approach are encountered even among different panels of the same court. Compare the present case with the decision of another panel of the 8th Circuit in *John Deere Co.* v. *Graham*, 333 F. 2d 529 (1964), cert. pending, No. 580.

among the Courts of Appeals, caused by the absence of any decision of this Court concerning the question of patent validity in the past fourteen years. But perversion of the standard of patentability which this Court had repeatedly announced in its decisions through 1950 need not necessarily take the shape of explicit assertions in the Courts of Appeals that this Court's decisions no longer state the law.[10] The Constitutional standard of patentability can be just as effectively watered down by a pattern of adjudication —ostensibly on the basis of determinations of fact— which has the practical effect of causing that standard to be debased. *Cf. Rogers* v. *Missouri Pacific R. Co.*, 352 U.S. 500, 509-10 (1957).

We submit that the present case, in which the Patent Office patented—and the lower courts sanctioned the patenting of—a transitory, petty refinement of a gadget containing nothing worthy of the name of invention, is an appropriate place for this Court to reassert its supervisory power over the Courts of Appeals in order to preserve the standards laid down by its decisions. Statistical evidence indicates that the restatement and reiteration of the governing standard of invention by

---

[10] There are such explicit assertions in certain of the cases. See Comment, 63 Colum. L. Rev. 306, 324 (1963). These assertions grow out of the conflict in the Courts of Appeals as to whether the passage of the Patent Code of 1952 had the effect of lowering the standard of invention laid down by this Court's decisions in the field discussed at pages 16-18, *infra*, culminating in the case of *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147 (1950). Obviously this patent could only, in point of fact, be upheld by applying a greatly reduced standard of invention, despite the language of the Court below. If certiorari is granted, we shall of course argue that Congress in enacting the 1952 Patent Code did not mean to lower the substantive standard of invention applied in the decisions of this Court.

this Court from time to time has a positive effect in supporting that standard in the lower courts.[11]

But even if it were assumed that a reiteration of the governing principles would not *in itself* be effective, we urge nonetheless that the Court here abandon the approach of non-review of this issue which it has embraced for over a decade. The present decision—though apparently the worst—is not an isolated example of the debasement of the standard of patentability by the Courts of Appeals.[12] This repeated misapplication of the standard of invention in the Courts of Appeals, in upholding patents on trivial refinements in gadgets,[13] indicates that this

---

[11] It is reported that a drop in the number of litigated patents upheld in the courts followed this Court's decision in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84 (1941). See Comment, 63 Colum. L. Rev. 306, 308 (1963). Moreover, an analysis of the tables set forth in "An Analysis of Patent Litigation Statistics," *supra* note 7, at 24-25, indicates that the statistical incidence of patents being held invalid was higher for the first four-year period following this Court's last decision in the area of patent validity, *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147 (1950), than in the second four-year period. Upon comparison of the periods 1951-54 and 1955-58, it appears that while the total number of patents declared invalid in the Courts of Appeals was almost exactly the same during the two periods, the number of patents upheld increased more than 50 per cent in the second period over the first.

[12] However, the decision's emphasis on the "commercial success" of the application of the patent is extreme and, as we discuss below, poses a clear, independent ground for review.

[13] Other examples include: *Radiator Specialty Co.* v. *Micek*, 327 F. 2d 554 (9th Cir. 1964), cert. denied, No. 121, October 12, 1964 (toilet flusher); *Zysset* v. *Popeil Bros., Inc.*, 276 F. 2d 354 (7th Cir. 1960), cert. denied, 364 U.S. 827 (1960), 318 F. 2d 701 (7th Cir. 1963), cert. denied, 376 U.S. 913 (1964) (vegetable chopper); *Beatty Safway Scaffold Co.* v. *Up-Right, Inc.*, 306 F. 2d 626 (9th Cir. 1962), cert. denied, 372 U.S. 934 (1963) (hinged framework

Court should begin once again to participate in the decisional process in this area.

Review should thus be granted in this case on a supervisory basis to "correct instances of improper administration" of the governing standard and "prevent its erosion" by a pattern of repeated misapplication. *Rogers* v. *Missouri Pacific R. Co., supra,* at 509. Cases like *Rogers* teach that the certiorari jurisdiction exists not only to enunciate the governing legal standards, but to ensure their application in practice where there is substantial and clear evidence of their misapplication. As this Court has recognized, the standards are meaningless if not applied. This Court thus has a supervisory or policing function to perform. As a perceptive commentator has put it: "Nonetheless, harking back to the instances discussed

---

for scaffolding); *Castro Convertible Corp.* v. *Bebry Bedding Corp.*, 291 F. 2d 306 (2d Cir. 1961), cert. denied, 368 U.S. 925 (1962) (ottoman convertible into bed); *Reiner* v. *I. Leon Co.*, 285 F. 2d 501 (2d Cir. 1960), cert. denied, 366 U.S. 929 (1961) (metal hair curl clip); *Norman* v. *Lawrence*, 285 F. 2d 505 (2d Cir. 1960) (rubber earring pads); *Squeez-A-Purse Corp.* v. *Stiller*, 280 F. 2d 424 (6th Cir. 1960), cert. denied, 364 U.S. 828 (1960) (rubber coin purse); *Amp Inc.* v. *Vaco Products Co.*, 280 F. 2d 518 (7th Cir. 1960), cert. denied, 364 U.S. 921 (1960) (screw cutter); *J. R. Clark Co.* v. *Geuder, Paeschke & Frey Co.*, 259 F. 2d 737 (7th Cir. 1958), cert. denied, 359 U.S. 914 (1959) (ironing board); *Ry-Lock Co.* v. *Sears, Roebuck & Co.*, 227 F. 2d 615 (9th Cir. 1955), cert. denied, 350 U.S. 987 (1956) (device for holding frameless window screens through levers on the sill); *Helms Products, Inc.* v. *Lakeshore Manufacturing Co.*, 227 F. 2d 677 (7th Cir. 1955) (springs holding backlighted transparent picture tight in frame).

We do not mean to suggest that the current of adjudication in the Courts of Appeals represented by this case and those cited is universal or close to it. Numerous decisions in the Courts of Appeals appear properly to apply the standards enunciated by this Court.

earlier, the fields of patents and of jury trials . . . the Court's practical choices are either to give up the battle and accept defeat or to say 'No, no, no.'" Frank, Marble Palace (1958), p. 288.

That a District Court, and a unanimous Court of Appeals, could come to find invention in a bottle cap, demonstrates the consequences of this Court's approach of non-review in patent validity cases. "Perhaps the greatest single failure of the Supreme Court is in relation to the patent system. . . . To sum it up, in the war between the Patent Office and the Supreme Court, the Supreme Court has lost." *Id.*, at 24, 27.

This case, we submit, offers an ideal opportunity for this Court once again to participate in the course of adjudication in this area, and by its participation to curb the lowering of standards of which this case and the other Court of Appeals cases cited above are indicative. This case does not involve an abstruse patent in the field of electronics or chemistry, but a simple, mechanical patent on an everyday household gadget. Moreover, it involves a combination patent; a type of patent which affords a particular opportunity for abuse—through the subtraction of old elements from the public domain—and with respect to which it is essential that proper standards be maintained.[14] The implications of this upon the ideal of free competition are obvious. Finally, the case affords the Court an opportunity to halt the spread of a doctrine which makes commercial success or com-

---

[14] See *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147, 151-52 (1950).

mercial innovation a substitute for the basic constitutional requirement of invention.[15]

Certainly there is every reason for the Court to step into the current of adjudication in this area once again at this time. The Patent Office grants about 50,000 patents, on the average, per year.[16] The record of this case vividly illustrates the practice it follows in granting a patent if there is any detail, however trivial, not explicitly and completely covered by the prior art.[17] It is notorious, and has been noted by

---

[15] We discuss this point at pages 18-21, *infra*.

[16] U.S. Patent Office, Index of Patents (1963), p. 1123. "At the other end of the production line, the Patent Office, which controls this endless sausage-grinder, rolls out the product and refuses to budge. An intensive reading of ten years of the *Journal of the Patent Office Society* reveals that the Office has taken every attitude about its invariable reversals in the Supreme Court, except one: nowhere has there been an expression of a desire to comply with the decisions . . ." Frank, Marble Palace (1958), p. 26.

[17] At first, the Scoggin patent application claimed the whole spray pump and plunger, as well as an overcap, in the broadest terms. (R. 353-54; 243). After rejection of the original claims, the making of further claims, and their rejection in turn (R. 358-69), in which twenty-four claims were submitted and rejected or cancelled, Scoggin finally focused on the seal and the idea of providing a clearance between the bottom of the overcap and the shoulder of the plunger assembly, so that the seal could be effected when the overcap was screwed on. (R. 251, 370-73). This followed upon an interview, as Scoggin put it, "courteously granted by the Honorable Examiner and the cooperation received in the drafting of allowable claims." (R. 371). As petitioner's expert, former Patent Commissioner Lawrence Kingsland, put it: "I have seen it happen where there is an interview with the Examiner, and the Examiner says, 'Well, I don't see much in it, but I haven't a direct reference.'" (R. 254). As a perceptive observer has put it: "The situation is aggravated, however, by still other factors. The most serious of these is the *ex parte* nature of the proceedings, as a result of which only the examiner's sense of public duty and conscientiousness stand in the way of granting the applicant's re-

Committees of Congress, that the Office's standards of invention are materially lower than those applied by the courts.[18]

The consequences to the goal of free competition in the national economy implicit in the standards of the Patent Office are obvious. Each improperly issued patent has the capacity of subjecting industry to an improper monopoly for a period of seventeen years. Moreover, the aggregation of a great number of patents, good, bad and indifferent, is a frequent tool of the antitrust violator;[19] and this and other types of patent misuse are greatly aided by low standards in issuing and judicially reviewing patents.

---

quest for a patent . . . . The whole thrust of the administrative process in the Patent Office pushes the examiner in the direction of allowing, rather than disallowing, applications." Stedman, The U. S. Patent System and its Current Problems, 42 Texas L. Rev. 450, 476 (1964).

[18] See the references to various Subcommittee Reports discussing the "continuing gap between the views of the Patent Office and the U. S. Courts as to what is and what is not patentable" set out in "An Analysis of Patent Litigation Statistics," *supra* note 7, at 1. As a panel of the Court of Appeals for the Second Circuit once dryly commented: "Since 1950, eighteen patents on different variations of hardware for use in reclining chairs with movable leg-rests have been issued. Obviously there have not been eighteen 'inventions' in this narrow area in the last twelve years." *Lorenz* v. *F. W. Woolworth Co.*, 305 F. 2d 102, 105 n. 6 (1962).

[19] See *United States* v. *Univis Lens Co.*, 316 U.S. 241 (1942); *United States* v. *Masonite Corp.*, 316 U.S. 265 (1942); *Hartford-Empire Co.* v. *United States*, 323 U.S. 386 (1945); 324 U.S. 570 (1945); *United States* v. *National Lead Co.*, 332 U.S. 319 (1947); *United States* v. *United States Gypsum Co.*, 333 U.S. 364 (1948); *United States* v. *New Wrinkle, Inc.*, 342 U.S. 371 (1952); *United States* v. *Besser Mfg. Co.*, 96 F. Supp. 304 (E.D. Mich. 1951), aff'd, 343 U.S. 444 (1952); *United States* v. *United Shoe Machinery Corp.*, 110 F. Supp. 295 (D. Mass. 1953), *aff'd per curiam*, 347 U.S. 521 (1954); and *United States* v. *Singer Mfg. Co.*, 374 U.S. 174 (1963).

This Court recently struck down an attempt by a patentee to extend the life of his patent beyond the seventeen years provided by law. *Brulotte* v. *Thys Co.*, No. 20, decided November 16, 1964. But more serious is the neglected problem of the extension of the patent monopoly to devices which are not inventions. We respectfully submit that this case furnishes an excellent opportunity for this Court to exercise its supervisory powers to prevent further erosion of the standard of patentability.

II. AS TO THE SUBSTANTIVE ISSUES

1. *Debasement of the Standard of Invention.*—On its merits, this case represents the nadir of a long line of recent cases in which the Courts of Appeals have sanctioned the patenting of petty modifications in trivial gadgets. This drift in the decisions of the lower courts makes a mockery of the standard of "invention" laid down in the Constitutional provision dealing with patents, and in the leading decisions of this Court. The patented bottle cap itself—nine examples of which we have lodged with the Clerk—is the strongest witness of the lack of invention in the patent at bar.

In *Electric Cable Joint Co.* v. *Brooklyn Edison Co.*, 292 U.S. 69, 79 (1934), this Court stressed that what was required for patentability was "invention, not the mere exercise of the skill of the calling." In *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84 (1941), the Court observed that the statute required (as it still does, 35 U.S.C. § 101) that "the device must not only be 'new and useful', it must also be an 'invention' or 'discovery' " (*Id.*, at 90).

Enunciating the standard involved, and stressing its derivation from the Constitution, this Court has

declared that the patentee's "skill in making [his] contribution" must reach "the level of inventive genius which the Constitution, Art. I, § 8, authorizes Congress to reward." (*Id.*, at 91). In *Jungersen* v. *Ostby & Barton Co.*, 335 U.S. 560, 566 (1949), the Court reiterated that the standard of patentability is "inventive genius." In its most recent decision in this field, *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147, 150 (1950), the Court reiterated the need for "invention."

The exercise of "inventive genius" in this case consisted of taking a plunger cap which had been fully disclosed in a twenty-year-old expired patent (Lohse), and changing the location of the cap seal—to a location in turn taught in a seven-year-old patent (Mellon)![20] The technique of the seal was, at the very most, as sophisticated as the common washer, and is old in the art.

It is ludicrous to think of the patent in suit as pushing back the frontiers of physics or of mechanics. It represents not an act on the stage of the unfolding of man's knowledge of the physical world about him, but an episode in the puppet theatre of gadgetry. —And a minor episode, at that, because even to the trivial subject matter to which it addressed itself, it contributed nothing new or lasting.[21]

---

[20] Moreover, the Livingstone patents taught the location and an even superior technique for the cap seal. See p. 7, *supra*.

[21] As noted in the Statement of Facts, by the time the patent issued, petitioner was using an improved type of overcap seal, which respondent itself adopted by the end of the year. Moreover, by the time the patent issued petitioner had come forward with internal seals in the pump itself, which prevent the toxic substances from even entering the overcap, from which they will of course flow when removed by the housewife. Respondent, again, followed suit with this same improvement over a year later in the Bakan 3.

The court below protested that it was applying the "exacting standard" of this Court's decisions. But in sanctioning the patent in suit the court below paid mere lip service to that standard. It is hard to conceive of a more lax standard than the one which grants the tinker's rearrangement in question here a seventeen-year monopoly. We submit that, in a century in which man has unlocked the secrets of the atom and in which travel to the moon lies at his feet, it is a perversion of language and law to call the reshuffling of the elements of a bottle cap an invention.

A case which demonstrates the drift to lax standards as vividly as this one, warrants this Court's corrective intervention by way of certiorari. It is hard to imagine what sort of gadget could not be patented if the approach of the decision below, left unreversed, were followed.

2. *Commercialization Substituted for Invention.*— The real basis for the decision below was not the presence of any invention in the bottle cap shown in respondent's patent but the "commercial success" of respondent's sprayer. (See App., pp. 8a-9a, *infra.*) Nothing more is meant by this than the fact that respondent was first to mass-market liquid insecticide with an in-place plastic sprayer and overcap.[22] The

[22] The District Court found that the respondent's patent was a commercial success apparently on the basis of the fact that respondent sold "millions" of the devices (including, of course, mounting them on its own insecticides). But the record is undisputed that the respondent's sales the first year it introduced the device did not increase and in fact may have declined. (R. 62). This is an odd form of "commercial success." The record is also clear that the device produced under the Scoggin patent, the Bakan

holding flies in the face of this Court's admonition that "commercial success without invention will not make patentability," *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp., supra,* at 153, and its characterization of it as, necessarily, a "make-weight," *Jungersen* v. *Ostby & Barton Co.,* 335 U.S. 560, 567 (1949). "In cases of patents on devices improving an existing product, there is every reason to severely limit the weight attributed to commercial success. The distinction between a mere improvement and an invention is well known in the law of patents, and incorporation of a device by manufacturers can be explained solely by the former." *Lorenz* v. *F. W. Woolworth Co.,* 305 F. 2d 102, 104 n. 4 (2d Cir. 1962). "Most important, it must be emphasized that the patent system is written in terms of encouraging and protecting invention, *not* innovation." Stedman, *The*

---

2 sprayer, was primarily developed for use on respondent's own insecticides. (R. 153). It was not until a year after respondent introduced its sprayer cap that it began to sell it to other concerns. (R. 153). It was not long thereafter that respondent had to bring out its improved Bakan 2 Modified model, adopting the seal used by petitioner (R. 341), and that Scoggin himself filed a further patent application (R. 496) in which he admitted that existing devices (presumably his own) were "prone to leak" (R. 497) and that what was needed was a device that prevented "leakage into the cap" (R. 497), that is, the internal pump seals already found on petitioner's SS-40.

The only other evidence of commercial success, besides respondent's understandable use of its own device, was the testimony of an executive of a liquid window cleaner concern. He testified that his product's sales increased substantially after he began using the Bakan 3 device. But previously, he had furnished no sprayer whatsoever with his product (while the label blithely instructed the housewife to "Spray on"); moreover, it should be remembered, the Bakan 3 device was respondent's ultimate model, which followed the features of petitioner's SS-40 and not the device disclosed in the Scoggin patent, which was admittedly imperfect. (R. 157, 341).

U. S. Patent System and its Current Problems, 42 Texas L. Rev. 450, 474 (1964).[23]

The reasons for this Court's rule about commercial success are vividly demonstrated by the facts at bar. Respondent receives a seventeen-year monopoly for no reason other than being the first company to happen to market a particular gadget in quantity. The result —particularly in the area of mass-marketed consumer goods—is to put a premium not on invention, but on factors alien to it, such as sales promotion, manufacturing technique, ready access to markets, and advertising techniques. The approach of the Court below favors the vertically integrated operator—like respondent, with a ready captive market in its insecticide manufacturing operations; it favors the corporate technician,[24] with immediate commercial outlet for his developments, over the independent inventor; it favors the production of gadgets with immediate commercial application o the performance of basic research.

In short, the test of commercial success applied below, in contradiction of the policies embodied in the antitrust laws, extends monopoly on the basis of promotional success[25] or distributional advantage,

---

[23] "An increasingly popular contention is that the patent system is not limited to stimulating inventive activity, but plays an equally or more important role in encouraging commercial *exploitation* and *innovation*. . . . [B]ut the fact remains that our patent system is *not* written in these terms. The criterion for patenting is the creation of an 'invention'. . . . *Id.*, at 454.

[24] Scoggin was an officer of the respondent corporation (R. 144).

[25] One of the attractive features of the Bakan 2 device, used on respondent's insecticides, was that the relatively flat top of the overcap furnished a convenient place for the supermarket to stamp the price. (R. 306). There was no evidence causally linking the so-called "commercial success" enjoyed by the Bakan 2 with any "invention" it might have embraced. This has been

while ignoring invention—the only constitutional basis for the patent monopoly.

This case accordingly provides, in addition to a vivid example of the application of a debased standard of invention, an object lesson in the anticompetitive effect of the substitution of commercialization for invention. A growing number of the recent decisions permitting the patenting of trivial devices are engaging in this fallacy.[26] This factor furnishes an independent reason making this case an appropriate vehicle for the grant of certiorari.

CONCLUSION

For the reasons stated, this Petition for Certiorari should be granted.

Respectfully submitted,

ABE FORTAS
VICTOR H. KRAMER
DENNIS G. LYONS
1229 Nineteenth Street, N.W.
Washington, D. C. 20036
Attorneys for Petitioner

Of Counsel:

FRANCIS G. COLE
WATSON, COLE, GRINDLE & WATSON

ARNOLD, FORTAS & PORTER

December 1964.

---

repeatedly held a fatal omission. See *Jungersen* v. *Ostby & Barton Co., supra,* at 568; *Lorenz* v. *F. W. Woolworth Co.,* 305 F. 2d 102, 104 n. 4 (2d Cir. 1962).

[26] See *Castro Convertible Corp.* v. *Bebry Bedding Corp., supra,* 291 F. 2d, at 307-08; *Reiner* v. *I. Leon Co., supra,* 285 F. 2d, at 503-04; *Norman* v. *Lawrence, supra,* 285 F. 2d, at 506; *Squeeze-A-Purse Corp.* v. *Stiller,* 175 F. Supp. 667, 669 (N.D. Ohio 1959), *aff'd per curiam,* 280 F. 2d 424, *supra; Amp Inc.* v. *Vaco Products Co.,* 280 F. 2d, at 519; *J. R. Clark Co.* v. *Geuder, Paeschke & Frey Co., supra,* 259 F. 2d, at 738.